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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,015	06/25/2001	Lionel Breton	016800-450	9059

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EXAMINER

WARE, TODD

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/888,015

Applicant(s)

BRETON ET AL.

Examiner

Todd D Ware

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-41, 52-56 and 62-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-41, 52-56 and 62-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Receipt of request for extension of time (granted) and notice of appeal both filed 9-9-02 and amendment filed 11-12-02 is acknowledged. Claims 57-61 and 65 have been canceled and claims 27-31 and 62 have been amended. Claims 27-41 and 52-56, and 62-64 are pending. In view of Applicant's comments regarding previous claims 57-61, and the new grounds for rejection, this action is non-final.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 27-31 are rejected 35 U.S.C. 103(a) as being unpatentable over any one of Onuma et al et al (JP 05105620; hereafter '620) or Hotta et al (JP 62036305; hereafter '305) or Naeshiro et al (JP 04009317; hereafter '317) or Onuma et al (JP 051056⁶⁴³34; hereafter '634) in combination with Shirota et al (JP 06227959 ; hereafter '959).

'620, '305, '317, and '634 all teach hydroxycinnamic acid derivative cosmetic compositions for lightening skin. No patentable weight is afforded the process limitations and it is submitted that since the amount of hydroxycinnamic acid derivative in the compositions of these references is at least that provided in the instant

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specification, the amount of hydroxycinnamic acid derivative in these references would be effective as required in the instant claims.

'959 teaches cinnamic aldehyde derivative cosmetic compositions for lightening skin. No patentable weight is afforded the process limitations and it is submitted that since the amount of hydroxycinnamic acid derivative in the compositions of these references is at least that provided in the instant specification, the amount of hydroxycinnamic acid derivative in these references would be effective as required in the instant claims.

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to combine the references with the motivation of providing an additive effect for skin whitening upon the formulations, since it is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. See *In re Kerkhoven*, 205 USPQ 1069 (CCPA 1980) and MPEP 2144.06. Furthermore, it is submitted that it would have been obvious to one skilled in the art at the time of the invention to adjust the amount of hydroxycinnamic acid derivative or cinnamic aldehyde derivative in the compositions to provide a greater or lesser degree of skin whitening based upon the motivation of a greater or lesser need/desire for more or less skin whitening.

Response to Arguments

3. Applicant's arguments with respect to claims 27-31 have been considered but are moot in view of the new ground(s) of rejection.

4. Claims 32-41, 52-56 and 62-64 are rejected 35 U.S.C. 103(a) as being unpatentable over any one of Onuma et al et al (JP 05105620; hereafter '620) or Hotta et al (JP 62036305; hereafter '305) or Naeshiro et al (JP 04009317; hereafter '317) or Onuma et al (JP 05105634; hereafter '634) in combination with Shirota et al (JP 06227959 ; hereafter '959) and further in combination with in view of Szijarto nee Auber et al (4,466,961; hereafter '961) **or any one of** Onuma et al et al (JP 05105620; hereafter '620) or Hotta et al (JP 62036305; hereafter '305) or Naeshiro et al (JP 04009317; hereafter '317) or Onuma et al (JP 05105634; hereafter '634) in combination with Shirota et al (JP 06227959 ; hereafter '959) and further in combination with McAuslan (WO 88/01166; hereafter '166).

'620, '305, '317, '634, and '959 are relied upon for all that they teach as stated previously. None of these references teaches inclusion of at least one other product that stimulates collagen synthesis and/or lipid synthesis.

'961 and '166 each teach inclusion of plant hormones in topical compositions to stimulate endothelialization and angiogenesis.

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to combine either '620, '305, '317, '634 with '959 and '961 or to combine either '620, '305, '317, '634 with '959 and '166 and include a plant hormone in the composition of these references to impart the properties disclosed in '961 or '166 upon these compositions with the motivation of providing nutrients to the skin.

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5. Applicant's arguments with respect to claims 32-41, 52-56 and 62-64 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 27-41, 52-56 and 62-64 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-23 of copending Application No. 09/887,073. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim cinnamic acid compositions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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8. Applicant's arguments filed 11-12-02 have been fully considered but they are not persuasive. Applicant has requested holding this rejection in abeyance until indication of allowable subject matter. Accordingly, the rejection is maintained.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd D Ware whose telephone number is (703) 305-1700. The examiner can normally be reached on M-F, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on (703)308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

tw
January 13, 2003